

REMARKS:

Applicants have now had an opportunity to carefully consider the Examiner's comments set forth in the Office Action of June 26, 2008. Claims 1, 3-11, and 32-37 remain pending, with claim 1 being an independent claim. By this Amendment, Applicants have amended claim 1.

Claims 1, 3-11, and 32-37 remain in this application and are believed to be in proper condition for allowance. Review and consideration of the claims are respectfully requested.

Rejection of Claims 1, 3-11, and 32-37 under 35 U.S.C. § 103

In the Office Action, the Examiner rejected claims 1, 10, 32, and 36 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication Number 2001/0039590 A1 to Furukawa et al. ("*Furukawa*") in view of "HKU Campus Network Handbook Chapter 4- Network Printing (HKU Campus Network Handbook – Last Update 7/16/1998, Chapter 4- Network Printing", hereinafter "*HKU*"). In response, Applicants respectfully submit that the claims are allowable for at least the following reasons:

Independent claim 1 is directed to a method of configuring a peripheral device on a network which requires, *inter alia*, determining by the host whether to configure the peripheral device, without user intervention. *Furukawa* in Fig. 5 discloses various steps performed by a host computer for setting address information, such as an IP address for network printers. In *Furukawa*, after the host computer displays the list of MAC addresses and list of printers, the host computer waits for input from the user and judges whether the user has selected one of the printer names from the displayed list. (See Fig. 5; page 1, paragraphs [0014]; page 3, paragraph [0037]). The user selects the node or network printer to set with address information and inputs the address information. (See *Furukawa*, Fig. 5; page 1, paragraphs [0014]; page 3, paragraph [0037]). Thus, in *Furukawa* the host computer is setting the IP address of the network devices based on a selection made by a user and this configuration of peripheral devices by the host computer is not without user intervention, as required by the claimed invention. Therefore, *Furukawa* fails to disclose or suggest the element of "determining whether to

configure the peripheral device, without user intervention,” of the claimed invention, and *HKU* fails to cure the defects of *Furukawa*.

Further, independent claim 1 requires, *inter alia*, that the configuration message include both a network parameter associated with a network connection of the peripheral device and a functional parameter associated with a device specific operation of the peripheral device, the updated configuration setting generated and sent by the host without user intervention.

HKU discloses a method of manually configuring a standalone PC for network printing (i.e., printing by sending data from the PC to a local printer or a network printer). (See Chapter 4, page 1). An Add Printer Wizard, requiring user intervention, is first used to add a local or network printer, and after the printer is added, a user selects desired printer settings (e.g., paper size, number of copies, form feed, etc.). (See *HKU*, Chapter 4, page 5, section 4.3, steps 10-15).

Assuming, *arguendo*, the printer setting being changed in *HKU* is a “functional parameter associated with a device specific operation of the peripheral device” of the claimed invention, the device being configured in *HKU* is the standalone PC and not the peripheral device, as in the claimed invention.

Additionally, the printer settings in *HKU* are set or changed by a user of the PC by clicking the button tag “Printer Settings” and checking the check boxes that correspond to the settings selected by the user. (See, Chapter 4, page 5, section 4.3, step 15). In Applicants’ claimed invention, the functional parameter associated with a network device is generated and sent by the host without user intervention. Thus, Applicants respectfully disagree that *HKU* discloses the configuration message including functional settings as in the claimed invention.

Moreover, *Furukawa* discloses a method of a host assigning an IP address to a network device irrespective of the type of network device. (See page 3, paragraph [0044]). In *Furukawa*, a host has no need to know the type of network device or the desired functional parameters of the device to assign an IP address, and Applicants respectfully submit that a person of ordinary skilled in the art would have no motivation to send the device-specific settings of *HKU* to the peripheral devices in *Furukawa*.

Therefore, Applicants respectfully submit that the combination of the two references cannot disclose or suggest the claimed invention and independent claim 1 is allowable for at least these reasons. Dependent claims 10, 32 and 36 which depend from independent claim 1 are also allowable for at least these same reasons.

The Examiner has rejected claims 3, 7-9, 11, 33-35, and 37 under 35 U.S.C. § 103(a) as being unpatentable over *Furukawa* in view of U.S. Patent Application Publication Number 2003/0084132 A1 to Ohta ("*Ohta*").

As discussed above, with respect to the elements in independent claim 1, *Furukawa* fails to disclose or suggest the claimed invention, and *Ohta* fails to cure the defects therein. Thus, the combination of the two references cannot disclose or suggest the claimed invention, and claims 3, 7-9, 11, 33-35, and 37 which depend from claim 1 are also allowable for at least the same reasons as claim 1.

The Examiner has rejected claims 4, 5, and 6 under 35 U.S.C. § 103(a) as being unpatentable over *Furukawa* in view of *HKU* further in view of U.S. Patent Application Publication Number 2002/0078161 A1 to Cheng ("*Cheng*").

As discussed above, with respect to the elements in independent claim 1, *Furukawa* in view of *HKU* fails to disclose or suggest the element of the claimed invention, and *Cheng* fails to cure the defects therein. Thus, the combination of the three references cannot disclose or suggest the claimed invention, and claims 4, 5, and 6 which depend from claim 1 are also allowable for the same reasons as claim 1.

Conclusion

For the foregoing reasons, Applicants respectfully submit that no cited reference, alone or in combination with other cited references, teaches, discloses, or suggests the subject matter of the pending claims. The pending claims are therefore in condition for allowance, and Applicants respectfully request withdrawal of all rejections and allowance of the claims. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is

invited to telephone or email the undersigned using the contact information provided below.

Respectfully submitted,

A handwritten signature in black ink, reading "Christine K. Garcia", written over a horizontal line.

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